UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,020	07/31/2003	Carl Smith	VISAP076/P-13601	4731

75458 7590 07/08/2009		

Beyer Law Group LLP/Visa
P.O. BOX 1687
Cupertino, CA 95015-1687

EXAMINER
COLAN, GIOVANNA B

ART UNIT	PAPER NUMBER
2162	

MAIL DATE	DELIVERY MODE
07/08/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/633,020	SMITH ET AL.
	Examiner	Art Unit	
	GIOVANNA COLAN	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 February 2009</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 –6, and 11 – 16</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1 –6, and 11 – 16</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
       1.☐ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is issued in response to the Amendment filed on 02/25/2009.

2.   Claims 1 – 4, 6, 11, 13 – 14, and 16 were amended. Claims 7 – 10, and 17 – 35

were canceled. No claims were added.

3.   This action is made Final.

4.   Claims 1 –6, and 11 – 16 are pending in this application.

Response to Arguments

5.   Applicant's arguments with respect to claims 1 –6, and 11 – 16 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

8.   Claim 1 – 3, 6, 11 – 13, and 16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Tushie et al. (Tushie hereinafter) (US Patent No. 6,014,748) in view

Du et al. (Du hereinafter) (US 2001/0042212).

Regarding Claim 1, Tushie discloses a method for automating the

personalization of a batch of smart cards that originates with a smart card issuer (Col. 5

and 6, lines 66 – 67 and 1 – 5, Tushie), comprising:

executing a personalization assistant tool (Col. 2, lines 38 – 40, Tushie), said

software tool including a default member profile having default values for smart card

features, a smart card feature being a parameter representing a business requirement

of said smart card issuer dictating smart card usage (Col. 2 and 18, lines 39 – 40 and 5

– 24, "The card framework template record describes the structure of the chip on the

card. In the sample shown below, the $MF entry defines a root directory (3F00), while

$DF entries define a medical application (5F20), and an accounting application (5F10).

Within each directory are application-specific files defined by $EF entries, such as 6F00

containing the account name and 6F10 containing the account number. All file

descriptive data resides in the card framework template and is referenced at various

times during the smart card issuing process", wherein the card framework template

record corresponds to the default member profile claimed; and wherein entries, such as, account name and account number correspond to the default values for smart card features; Col. 2, lines 54 – 59; Col. 8, lines 48 – 51; Col. 14, lines 3 – 5; Col. 17, lines 9 – 12; and Col. 14, lines 22 – 33, Tushie).

Furthermore, Tushie also discloses a method and system for receiving smart card feature information (Page 6, lines 40 – 46, Tushie) that was previously entered into a cardholder database management system by a user (Fig. 1B, item 152, Page 7, lines 48 – 59, Tushie). In addition, Tushie discloses that the smart card personalization system will create smart cards according to the information received from alternate inputs (Col. 6, lines 54 – 56, Tushie) and from a software tool (Fig. 1A, item 150, Card Issuer Mgnt System, Page 9, lines 23 – 26 and 33 – 38; respectively, Tushie). However, Tushie does not expressly disclose the details on how the user enters such smart card information into the system. On the other hand, Du discloses computer instructions for providing a user with a plurality of queries regarding said smart card features said queries originating from said software tool ([0048], Du); receiving from the user responses to the plurality of queries, said responses being received by said software tool and reflecting smart card features desired by said smart card issuer ([0048], Du); matching each of said responses with an output data value, said matching being performed by said software tool, each of said output data values representing one of said smart card features and being suitable for personalizing a smart card ([0049], and [0050], Du). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Du as a method for users to enter

personalized information in the Tushie system at Fig. 1B, item 152, Card Holder Data,

to the smart card personalization system of Tushie. Skilled artisan would have been

motivated to do so, as suggested by Du ([0011], Du), to provide a smart card enabled

mobile personal computing environment system that creates an infrastructure for the

management of a user's personal computing environment data on a smart card.

The Tushie in view of Du combination (Tushie/Du hereinafter) also discloses:

modifying said default member profile to include said matched output data

values, said output data values replacing corresponding said default values for smart

card features (Du); and

generating a personalization data file from said modified default member profiles

([0050], Du), wherein said personalization data file is suitable for personalizing said

batch of smart cards and provides said smart card features on each smart card in said

batch of smart cards for a plurality of users wherein said batch of smart cards is

personalized with respect to the plurality of users by way of said output data values

(Col.6 and 9, lines 42 – 47 and 33 – 38; respectively, "… The smart card personalization

system 100 receives data from a card issuer management system 150 (typically

proprietary to the card issuer), translates the data into a data stream, and outputs the

data stream to personalization equipment 130 which personalizes the smart cards

160…"; Tushie; and [0050] and [0051], Du).

Regarding Claim 2, Tushie/Du discloses a method, further comprising:

using individual cardholder input files and the personalization data file to

personalize a said batch of smart cards to yield a plurality of personalized smart cards

(Col. 2, lines 46 – 54, Tushie; and [0050], Du).

Regarding Claim 3, Tushie/Du discloses a method, wherein said matching

includes:

providing a look up table with entries for various combinations of responses to

the plurality of queries (Col. 17, lines 13 – 25, Tushie; and [0055], records, Du);

finding a matching entry in the look up table that matches the responses to the

plurality of queries (Col. 17, lines 13 – 25, Tushie; and [0055], records, Du);

locating one of said output data values associated with the matching entry (Col.

17, lines 13 – 25, Tushie; and [0055], records, Du); and

outputting the one of said output data values associated to the matching entry

(Col. 17, lines 13 – 25, Tushie; and [0055], records, Du).

Regarding Claim 6, Tushie/Du discloses a method, further comprising providing

regional profiles and subregional profiles, wherein a subregion is within a region,

wherein the regional and subregional profiles have mandatory and recommended

settings, wherein some of the subregional profiles are more stringent than regional

profiles in which the subregions belong ([0046], and [0052], Du).

Claim 11 has been rejected under the same grounds as discussed in Claim 1.

Furthermore, Tushie/Du disclose: personalizing said batch of smart cards utilizing said

personalization data file, said personalization data file providing said smart card

features on each smart card in said batch of smart cards by was of said output data

values (Col. 2, lines 46 – 54, Tushie; and [0050], Du).

Regarding Claim 12, Tushie/Du discloses a computer implemented method,

further comprising:

sending the personalization data file to a preparation processing device (Fig. 1A,

item 100 and 150, Col. 6, lines 42 – 46, Tushie; and [0049], Du);

and

using the personalization data file and cardholder input files to personalize smart

cards (Fig. 1A, items 130 and 160, Col. 6, lines 45 – 47, Tushie; and [0049], Du).

Regarding Claim 13, Tushie/Du discloses a computer implemented method,

wherein said matching includes:

providing a look up table with entries for various combinations of responses to

the plurality of queries (Col. 17, lines 13 – 25, Tushie; and [0055], records, Du);

finding a matching entry in the look up table that matches the responses to the

plurality of queries (Col. 17, lines 13 – 25, Tushie; and [0055], records, Du);

locating one of said output data values associated with the matching entry (Col.

17, lines 13 – 25, Tushie; and [0055], records, Du); and

outputting the one of said output data values associated to the matching entry

(Col. 17, lines 13 – 25, Tushie; and [0055], records, Du).

Regarding Claim 16, Tushie/Du discloses a computer implemented method,

further comprising providing regional profiles and subregional profiles, wherein a

subregion is within a region, wherein the regional and subregional profiles have

mandatory and recommended settings, wherein some of the subregional profiles are

more stringent than regional profiles in which the subregions belong (([0046], and

[0052], Du).

10.   Claims 4 – 5, and 14 – 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Tushie et al. (Tushie hereinafter) (US Patent No. 6,014,748), in view

Du et al. (Du hereinafter) (US 2001/0042212), and further in view of Anderson et al.

(Anderson hereinafter) (US 5,884,289).

Regarding Claim 4, Tushie/Du discloses all the limitations as discussed above

including one query regarding offline limits and thresholds (Col. 6, lines 32 – 38,

Tushie). However, Tushie/Du does not explicitly disclose that said smart card features

include account usage control, and account risk management. On the other hand,

Anderson discloses smart card features including: account usage control, and account

risk management ([57], Abstract, Col. 7, lines 55 – 60, "allowing the card issuer to limit

the on-going losses on that card"; Col. 8, lines 35 – 42; "i. All ATM/POS transactions

(approved or declined) for sample cards going back for a period of time (e.g., 3 months)", wherein for example "3 months" is part of the usage information as claimed; Anderson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Anderson's teachings to the system of Tushie/Du. Skilled artisan would have been motivated to do so, as suggested by Anderson ([57], Abstract, Anderson), to identify "at risk" cards in the criminal's possession which have not yet been used, and to limit the losses to individual financial institutions and the financial institution community at large.

Regarding Claim 5, the combination of Tushie in view of Du and further in view of Anderson (Tushie/Du/Anderson hereinafter) discloses a method, wherein responses to the plurality of queries are used to provide best practices recommendations (Col. 8, lines 58 – 61, Tushie; and [0048], Du).

Regarding Claim 14, Tushie/Du/Anderson discloses a computer implemented method, wherein the plurality of queries, comprise:

at least one query regarding smart card account usage control ([57], Abstract, Anderson);

at least one query regarding smart card account risk management ([57], Abstract, Anderson); and

at least one query regarding offline limits and thresholds (Col. 6, lines 32 – 38, Tushie).

Regarding Claim 15, Tushie/Du/Anderson discloses a computer implemented

method, wherein responses to the plurality of queries are used to provide best practices

recommendations (Col. 8, lines 58 – 61, Tushie; and [0048], Du).

Conclusion

11.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIOVANNA COLAN whose telephone number is (571)272-2752. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Giovanna Colan
Examiner
Art Unit 2162
June 17, 2009

/John Breene/
Supervisory Patent Examiner, Art Unit 2162